



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,577	01/25/2002	Toshihiro Morita	275734US6PCT	4188
22850	7590	08/25/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/913,577

Applicant(s)

MORITA ET AL.

Examiner

Robert M. Pond

Art Unit

3625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on 9 . A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: . (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): .
6. ☐ Newly proposed or amended claim(s) would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: .
Claim(s) objected to: .
Claim(s) rejected: .
Claim(s) withdrawn from consideration: .

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☐ Other: .

Robert M. Pond
Primary Examiner

Continuation of 11. does NOT place the application in condition for allowance because: Stefik discloses original digital works, creating derivative works, and creating composite digital works, and defines a composite digital work comprising distinguishable parts, each of the distinguishable parts is itself a digital work which have usage rights attached. Stefik specifically discloses editing, copying, loaning, transferring, and extracting functions that facilitate creation of digital works, derivative digital works, and composite digital works. Stefik discloses assigning and tracking usage rights and specifically discloses the rights of a composite digital work being the minimal rights attached to a distinguishable part as determining the overall composite digital work usage rights. Stefik further discloses using a authoring tool or digital work assembly tool for creating a digital work having different usage rights for the varioius components (e.g. composite work).

Stefik discloses assigning and tracking usage rights associated with copying or loaning of digital works for use and preventing use once usage right is exhausted. Stefik discloses it being fundamental to the invention of Stefik that the usage rights are treated as part of the digital work...as the digital work is distributed, the scope of the granted usage rights will remain the same or may be narrowed. Stefik further discloses that the basic idea is that one cannot grant more rights than they have. By specific examples and disclosures, Stefik judges whether one or more digital works are in use (i.e. copies, loaned, transferred).

Inherent in Stefik are the structures necessary to permit combining the first and second contents together when it is determined by the first and second judging means that neither the first nor second content has been moved to another apparatus connected to the information processor. For example, if a user has been granted usage rights (e.g. one time or multiple times use as disclosed by Stefik based on discussion pertaining to copy count, single copy count) to Digital Work A (DWA) and Digital Work B (DWB), and DWA has been moved and in use with usage rights exhausted, but DWB usage has not been exhausted, when the user attempts to create a composite by combining DWA with DWB, the system will prevent DWA from being used again because one cannot grant more rights than they have. Likewise, if both DWA and DWB each have rights that have not been exhausted (e.g. DWA can be used one more time and DWB can be used two more times) then the composite of DWA and DWB would permit one use based on the rules disclosed by Stefik as noted above.

Pertinent citings: C6,36-50; C9,8-20; C11,30-67; C18,16-20, C19,65-C20,2; C21,1-22, 23-24; C23,31-32; C41,7-13; C46,15-33.